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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/837,009 04/11/97 BELL

G 2300.0202

EXAMINER

HM12/0301

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SAOUD, C

ART UNIT

PAPER NUMBER

1646

13

DATE MAILED:

03/01/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trad marks**

# Advisory Action

Application No.  
08/837,009

Applicant(s)  
BELL et al.

Examiner  
Christine Saoud

Group Art Unit  
1646



## THE PERIOD FOR RESPONSE: [check only a) or b)]

- a) ☐ expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☒ expires either three months from the mailing date of the final rejection, or on the mailing date of this Advisory Action, whichever is later. In no event, however, will the statutory period for the response expire later than six months from the date of the final rejection.

Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a), the proposed response and the appropriate fee. The date on which the response, the petition, and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee. Any extension fee pursuant to 37 CFR 1.17 will be calculated from the date of the originally set shortened statutory period for response or as set forth in b) above.

- ☐ Appellant's Brief is due two months from the date of the Notice of Appeal filed on \_\_\_\_\_ (or within any period for response set forth above, whichever is later). See 37 CFR 1.191(d) and 37 CFR 1.192(a).

Applicant's response to the final rejection, filed on Feb 1, 2000 has been considered with the following effect, but is NOT deemed to place the application in condition for allowance:

- ☒ The proposed amendment(s):
- ☐ will be entered upon filing of a Notice of Appeal and an Appeal Brief.
- ☒ will not be entered because:
- ☒ they raise new issues that would require further consideration and/or search. (See note below).
- ☐ they raise the issue of new matter. (See note below).
- ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.
- ☐ they present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE: Claims 23-24, 31, 46 are improperly dependent, claims 25-26, 42-43, 47-48 lack antecedent basis for IGF-I or IGF-II. The claims of this amendment which are not rewritten in the attachment should be resubmitted with the newly amended claims taking into consideration the suggestions provided in the attachment.

- ☐ Applicant's response has overcome the following rejection(s):

- ☐ Newly proposed or amended claims \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment cancelling the non-allowable claims.
- ☒ The affidavit, exhibit or request for reconsideration has been considered but does NOT place the application in condition for allowance because: supplemental  
Applicant still has not filed a properly executed declaration.

- ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

- ☒ For purposes of Appeal, the status of the claims is as follows (see attached written explanation, if any):

Claims allowed: none

Claims objected to: none

Claims rejected: 1-41

- ☐ The proposed drawing correction filed on \_\_\_\_\_ ☐ has ☐ has not been approved by the Examiner.

- ☐ Note the attached Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

- ☐ Other Clm. 3 of amendment contains a typo in line 2g: hIGF-I should be hIGF-II.

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*Attachment to Advisory Action*

Applicant's amendment, submitted 01 February 2000, could not be entered for the reasons on the Advisory Action. There are numerous errors regarding lack of antecedent basis, improperly dependent claims, and methods without proper method steps. In order to expedite prosecution, included with the Advisory Action are the following redrafted claims which should avoid all grounds of rejection and include that subject matter that Applicant wishes to claim.

Claim 1 - (change letter (d) as follows and add new letter (e)):

(d) a fragment of (a) or (b) that is at least 18 bases in length; and

(e) a fragment of (c) that is at least 18 bases in length.

Claim 8 - "A composition comprising cellular hosts transformed by a heterologous DNA molecule substantially free of cellular hosts that do not contain said heterologous DNA molecule, wherein said heterologous DNA molecule comprises a nucleic acid sequence selected from the group consisting of:" ....

Claim 23 - A method of producing a polypeptide comprising an amino acid sequence of Fig. 1 or Fig. 2, comprising culturing a suitable host cell transformed with a polynucleotide

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encoding said polypeptide, wherein the polynucleotide comprises a nucleic acid sequence selected from the group consisting of the nucleic acid sequence of Claim 2 or 3.

Claim 24 - A method of producing a polypeptide comprising an amino acid sequence of Fig. 1 or Fig. 2, comprising introducing into a suitable host cell a nucleic acid comprising a polynucleotide encoding said polypeptide, wherein the polynucleotide comprises a nucleic acid sequence selected from the group consisting of the nucleic acid sequence of Claim 2 or 3, and culturing said host cell.

Claim 31 - A method of producing a polypeptide comprising an amino acid sequence of Fig. 1 or Fig. 2 which comprises expressing the heterologous DNA in the transformed host cells of a composition of Claim 10 or 11.

Claim 32 - A method of producing a polypeptide according to claim 31 wherein the polypeptide has the amino acid sequence of Fig. 1 and said nucleic acid sequence is sequence (a).

Claim 33 - A method of producing a polypeptide according to claim 31 wherein the polypeptide has the amino acid sequence of Fig. 2 and said nucleic acid sequence is sequence (b).

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Claim 42 - A method according to claim 23 wherein the polypeptide has the amino acid sequence of Fig. 1 and the polynucleotide has the nucleic acid sequence of sequence (a).

Claim 43 - A method according to claim 23 wherein the polypeptide has the amino acid sequence of Fig. 2 and the polynucleotide has the nucleic acid sequence of sequence (b).

Claim 44 - A vector comprising a nucleic acid of claim 1.

Claim 45 - A vector according to claim 44 wherein said nucleic acid is (a).

Claim 46 (new claim) - A composition according to claim 1 wherein said nucleic acid comprises a nucleic acid sequence selected from the group consisting of (a), (b), or (d).

Claim 47 (previously claim 46) - An expression vector comprising a polynucleotide encoding a polypeptide, wherein the polypeptide comprises an amino acid sequence of Fig. 1 or 2, or fragments thereof, wherein said polynucleotide comprises the nucleic acid sequence of Claim 46.

✓ Claim 48 (previously claim 47) - An expression vector according to claim <sup>47</sup>~~46~~, wherein the polypeptide comprises the amino acid sequence of Fig. 1.

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✓ Claim 49 (previously claim 48) - An expression vector according to claim ~~46~~<sup>47</sup>, wherein the polypeptide comprises the amino acid sequence of Fig. 2.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christine Saoud, Ph.D., whose telephone number is (703) 305-7519. The examiner can normally be reached on Monday to Friday from 8AM to 3PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz, can be reached on (703) 308-4623. The fax phone number for this Group is (703) 308-0294.

Official papers filed by fax should be directed to (703) 308-4227. Faxed draft or informal communications with the examiner should be directed to (703) 308-0294.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Christine Saoud, Ph.D.  
February 21, 2000

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JOHN ULM  
PRIMARY EXAMINER  
GROUP 1600